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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,530	03/29/2005	Teresa Karjala	62144B	4556
109 7590 04/14/2009 The Dow Chemical Company Intellectual Property Section P.O. Box 1967 Midland, MI 48641-1967				
EXAMINER MCCAIG, BRIAN A				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
04/14/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/529,530

Applicant(s)

KARJALA ET AL.

Examiner

BRIAN MCCAIG

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Summary

1. This is the final Office action based on the 10/529530 application filed March 29, 2005, and amended January 5, 2009.
2. Claims 1-24 and the applicant's arguments have been fully considered.
3. Amendment of the specification is noted and the objection is withdrawn.

Response to Amendment

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1-5, 7-17, and 19-24 remain rejected under 35 U.S.C. 102(b) as being anticipated by ROSSI ET AL (US 5811379) alone or, alternatively, as evidenced by TSUTSUI ET AL (US 4704491), hereafter referred to as ROSSI and TSUTSUI, respectively.**
6. With respect to claims 1-5, 7-11, 13-17, and 19-23, ROSSI discloses a homogenous liquid/gel-like low molecular weight ethylene/ α -olefin polymer, which acts as a pour point reducing additive [column 31, line 63-column 32, line 1], wherein the α -olefin is comprised of ethylenically unsaturated monomers including C_3 - C_{20} α -olefins [column 12, lines 40-59], specifically, ethylene, 1-propene, 1-butene, 1-hexene, and 1-octene having a number average molecular weight (Mn) less than 9,000 [column 3, lines 35-50], a total crystallinity less than 2% [column 19, lines 64-65], and a comonomer incorporation of greater than 50 mol % [column 16, lines 12-34]. All property characteristics as instantly claimed are therefore considered inherent to Rossi.

7. Alternatively, ROSSI does not explicitly disclose the pour point of the ethylene/ α -olefin polymers but does disclose their beneficial effects on pour points of mixtures including the said polymers. However, it is well known to one of ordinary skill in the art that low-molecular weight ethylene/ α -olefin polymers such as those of ROSSI have a pour point less than 0° C as evidenced by TSUTSUI [see, e.g., table 3, examples 6 & 7].

8. With respect to claims 12 and 24, ROSSI discloses [column 31, lines 14-16] a synthetic oil for use as a lubricant oil comprising the liquid/gel-like low molecular weight ethylene/ α -olefin polymer in which the oil has a kinematic viscosity of 2-40 centistokes at 100° C.

9. **Claims 6 and 18 remain rejected under 35 U.S.C. 102(b) as being anticipated by ROSSI ET AL (US 5811379) taken singly or as further evidenced by TSUTSUI ET AL (US 4704491) and WITTCOFF ET AL in *Industrial Organic Chemicals* (2nd edition, 2004, 662 pgs, WILEY), hereafter referred to as ROSSI, TSUTSUI and WITTCOFF, respectively.**

ROSSI discloses a process comprising reacting ethylene and at least one ethylenically unsaturated monomer at a reaction temperature of at least 80° C (column 17, lines 17-24) in the absence of hydrogen [the process of ROSSI requires dilute monomers in which the diluent is a hydrocarbon inert absent hydrogen; see column 12, line 20-column 18, line 58], and in the presence of a single site catalyst [column 5, lines 32-34, which describes a late-transition-metal catalyst such as that illustrated by structure A, column 35, which is a single site catalyst as evidenced by WITTCOFF, page 498-499] to form a homogenous liquid low molecular weight ethylene/ α -olefin polymer having a number average molecular weight (Mn) less than 25,000 [column 3, lines 35-50], a total crystallinity less than 10% [column 19, lines 64-65], and a comonomer incorporation of greater than 15 mol % [column 16, lines 12-34]. ROSSI does not explicitly disclose the pour point of the ethylene/ α -olefin polymers but does disclose their beneficial effects on pour points of mixtures including the said polymers. However, it is well known to one of ordinary skill in the art that low-molecular weight ethylene/ α -olefin polymers such as those of ROSSI have a pour point less than 50° C as evidenced by TSUTSUI [see, e.g., table 3, examples 6 & 7].

Response to Arguments

10. Applicant's arguments filed January 5, 2009, have been fully considered but they are not persuasive.
11. The applicant argues that the initial Office action does not show each claim feature of the applicant's invention is expressly or inherently disclosed in Rossi.
12. The applicant's argument is not persuasive because the applicant has not discussed any particular shortcomings of the prior art with respect to the limitations of the claim. Therefore, the argument is indefinite. Furthermore, the Office action clearly discloses the similarity in feedstocks and catalysts (e.g. single-site or metallocene catalysts). Similarly, Rossi discloses similar polymerization conditions [column 17, lines 11-21 & 60-65] to those disclosed in the instant application. Therefore, the limitations of the claims are either expressly disclosed as indicated above or inherently contained within the reference.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
14. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN MCCAIG whose telephone number is (571) 270-5548. The examiner can normally be reached on M-F 8-430.

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16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Calderola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BAM
4/9/2009

/Glenn A Calderola/
Acting SPE of Art Unit 1797